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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,546	06/22/1999	SHIGEKI HIROOKA	35.G2410	9128

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NEW YORK, NY 10112

EXAMINER
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NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 10/28/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

**Office Action Summary**

Application No.

09/337,546

Applicant(s)

HIROOKA, SHIGEKI

Examiner

George C Neurauter, Jr.

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,8,10-16,22,24-30,36 and 38-40 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1,2,8,10-16,22,24-30,36 and 38-40 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1, 2, 8, 10-16, 22, 24-30, 36 and 38-40 have been examined.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 June 2003 has been entered.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1, 2, 8, 10-16, 22, 24-30, 36 and 38-40 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 8, 10-11, 13-16, 22, 24-25, 27-30, 36 and 38-40 rejected under 35 U.S.C. 102(e) as being anticipated by Paul (US Patent 5 999 932 A).

Regarding claim 1, Paul discloses an e-mail processing method comprising the steps of: identifying a type of each data included in a received e-mail, the received e-mail including a plurality of data; determining whether each data included in the received e-mail is to be utilized, in accordance with the identified type of each data; storing the data included in the received e-mail, if it is determined in said determining step that the data can be processed; and deleting the data included in the received e-mail, if it is determined in said determining step that the data cannot be processed (Figures 4 and 4A, specifically steps 402, 403, 412, 415, and 422; column 1, line 65-column 2, line 62; column 8, line 17-column 9, line 55, specifically column 8, line 17-column 9, line 19).

Regarding claim 2, Paul discloses a method according to Claim 1, further comprising the steps of: registering an arbitrary type of data that can be processed in advance; and determining that a data is can be processed when the identified type of data coincides with the registered type of data (Figure 2; column 1, line 65-column 2, line 62, specifically column 1, line 66-column 2, line 19 and column 2, lines 48-59; column 3, line 66-column 4, line 25).

Regarding claim 8, Paul discloses a method according to Claim 1, wherein a presence of a data that cannot be processed is notified to a user (Figures 4 and 4A, step 415; column 9, lines 1-19).

Regarding claim 10, Paul discloses a method according to Claim 1, wherein, when it has been determined that the data cannot be processed, a subsequent process

is selectable from among a plurality of predetermined processes. (Figure 6, step 650; column 9, line 56-column 10, line 11)

Regarding claim 11, Paul discloses a method according to Claim 1, wherein the type of data comprises a text. (column 4, lines 34-40)

Regarding claim 13, Paul discloses a method according to Claim 1, wherein identification of the type of data is performed by analyzing the received e-mail. (Figures 4 and 4A, step 403 and 412; column 8, line 17-column 9, line 55, specifically column 8, lines 17-34 and column 9, lines 32-55)

Regarding claim 14, Paul discloses a method according to Claim 1, wherein a character string is retrieved from the received e-mail, and the type of data is identified according to a reference character string specified based on a position in the received e-mail where the retrieved character string is present. (Figure 4, step 403; column 8, line 17-column 9, line 55, specifically column 8, lines 17-34)

Claims 15-16, 22, and 24-28 are rejected since these claims recite an e-mail processing apparatus that contain substantially the same limitations as recited in claims 1-2, 8, and 10-14 respectively.

Claims 29-30, 36, 38-40 are rejected since these claims recite a computer-readable storage medium storing control software for implementing an e-mail process that contain substantially the same limitations as recited in claims 1-2, 8, and 10, and 13-14 respectively.

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***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul.

Regarding claim 12, Paul discloses a method according to Claim 1.

Paul does not expressly disclose wherein the type of data comprises an image.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the nonfunctional descriptive material with the claimed invention because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim 26 is also rejected based the motivations regarding the obviousness of claim 12.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


US Patent 6 161 130 A to Horvitz et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C Neurauter, Jr. whose telephone number is 703-305-4565. The examiner can normally be reached on Monday-Saturday 5:30am-10pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-7240.

gcn

  
**BUNJOB JAREENCHONWANIT**  
**PRIMARY EXAMINER**